

# Notice of Allowability

Application No.

09/868,832

Examiner

BJ Forman

Applicant(s)

HIROTA ET AL.

Art Unit

1634

## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to papers filed 18 December 2003 and Examiners Amendments agreed to on 15 January 2004.
2. ☒ The allowed claim(s) is/are 1-4, 15-18, 22-25 and 30.
3. ☒ The drawings filed on 21 June 2001 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All b) ☐ Some\* c) ☐ None of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
  - \* Certified copies not received: \_\_\_\_\_.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No. \_\_\_\_\_.
  - (b) ☐ including changes required by the proposed drawing correction filed \_\_\_\_\_, which has been approved by the Examiner.
  - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

- |   |   |
|---|---|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892)   | 5 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                    |
| 2 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 6 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. <u>0104/1003</u> |
| 3 <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No. _____  | 7 <input checked="" type="checkbox"/> Examiner's Amendment/Comment                            |
| 4 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance           |
|   | 9 <input type="checkbox"/> Other _____  |

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## **NOTICE OF ALLOWANCE**

### ***Status of the Claims***

1. This action is in response to papers filed 18 December 2003 in which claims 15-18, 22-25 and 30 were amended and a Declaration filed under 37 C.F.R. 132 was submitted. All of the amendments have been thoroughly reviewed and entered.

The previous rejections in the Office Action dated 28 July 2003 are withdrawn in view of the amendments and Declaration filed 18 December 2003 and further in view of the Examiner's Amendments detailed below.

The amendments and Declaration place the pending claims in condition for allowance.

Claims 1-4, 15-18, 22-25 and 30 are in condition for allowance.

### **EXAMINER'S AMENDMENT**

2. An extension of time under 37 CFR 1.136(a) is required in order to make an examiner's amendment which places this application in condition for allowance. During a telephone conversation conducted on 15 January 2004, Steve Caldwell requested an extension of time for 1 MONTH(S) and authorized the Director to charge Deposit Account No. 501446 the required fee of \$520.00 for this extension and authorized the following examiner's amendment. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows:

a. In Claim 1, lines 1-2 replace "capture solutions" with --- DNA ---.

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- b. In Claim 1, line 3, before “capture solutions” delete “said”.
- c. In Claim 1, line 3, after “capture solutions” insert --- containing said DNA --- .
- d. In Claim 3, line 1 replace “capture solutions” with --- DNA ---.
- e. In Claim 3, line 3, before “capture solutions” delete “said”.
- f. In Claim 3, line 3, after “capture solutions” insert --- containing said DNA --- .
- g. In Claim 15, line 2, replace “capture solution” with --- DNA --- .
- h. In Claim 16, line 2, replace “capture solution” with --- DNA --- .
- i. In Claim 17, line 2, replace “capture solution” with --- DNA --- .
- j. In Claim 18, line 2, replace “capture solution” with --- DNA --- .
- k. In Claim 22, line 2, replace “capture solution” with --- DNA --- .
- l. In Claim 23, line 2, replace “capture solution” with --- DNA --- .
- m. In Claim 24, line 2, replace “capture solution” with --- DNA --- .
- n. In Claim 25, line 2, replace “capture solution” with --- DNA --- .
- o. In Claim 30, line 1, delete “of capture solutions”.
- p. In Claim 30, line 2, replace “a capture material” with --- DNA ---.
- q. In Claim 30, line 3, before “capture solutions” delete “said”.
- r. In Claim 30, line 3, after “capture solutions” insert – containing said DNA --- .
- s. In Claim 30, line 6, replace “the capture material” with --- said DNA ---.
- t. In Claim 30, line 7, replace “solution” with – solutions ---.
- u. Claims 1-4, 15-18, 22-25 and 30 have been renumbered Claims 1-13 according to 37

C.F.R. 1.126 (see MPEP 608.01 (j) and 608.01 (n) IV).

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### **REASONS FOR ALLOWANCE**

3. The following is an examiner's statement of reasons for allowance: The Declaration filed under 37 C.F.R. 132 provided clear and convincing evidence that the instantly claimed biochip made using an ink jet system is patentably distinct from the prior art biochip.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### **Conclusion**

4. Claims 1-4, 15-18, 22-25 and 30 are allowed.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (571) 272-0741 until 13 January 2004. The examiner can normally be reached on 6:00 TO 3:30 Monday through Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (703) 308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-0507.



BJ Forman, Ph.D.  
Primary Examiner  
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January 15, 2004